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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,736	01/24/2001	Martin John Callahan	600.1119	1235

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EXAMINER

NGUYEN, ANTHONY H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,736

Applicant(s)

CALLAHAN ET AL.

Examiner

Anthony H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,050,185. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure claimed in the present application differ from the structure and method claimed in the patent only by the broader language used in the claims.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Richards (US 6,050,185).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Claims 1,2,4,14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Volz et al. (US 5,826,505).

Volz et al. teaches an offset printing press which meets the structure as broadly claimed. Volz et al. teaches a printing press having plate cylinders (PT), blanket cylinders (GT), anilox inkers (D, R, HW) and drives or motors (AFW) as shown in Figs.1-4 of Volz et al.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,5,16, and 18 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Volz et al. (US 5,826,505) in view of Murray (US 6,041,706).

Volz et al. teaches an offset printing press having substantially the structure as claimed. See the explanation of Volz et al. above. Volz et al. fails to teach the ink form roll and the platen cylinder having the same diameter. However, Murray teaches the ink form rollers 44 which appear to be the same size with the plate cylinders 30. Therefore, it would have been obvious to one of ordinary skill in the art to modify the ink form roll of Volz et al. by substituting the ink form roll as taught by Murray for optimal of transferring ink to a printing plate. Note that various sizes of the plate cylinders 30a, 30b, 30c in Murray can be used (Murray, col.6 lines 42-55); therefore, the use of the plate cylinder or the form roller and the plate cylinder which has the same size or the same diameter in Murray would have been obvious.

Claims 6-13, and 15 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Volz et al. (US 5,826,505) in view of Puschmerat (US 5,950,538).

Volz et al. teaches an offset printing press having substantially the structure as claimed. See the explanation of Volz et al. above. Volz et al. fails to teach the first and second blanket cylinders which are directly geared together. However, Puschmerat teaches an offset printing

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press having blanket cylinders 4 and 6 which are directly geared together via gears 23 and 24 (Puschmerat, Fig. 1). In view of the teaching of Puschmerat, it would have been obvious to one of ordinary skill in the art to modify the drive system of Volz et al. by providing drive system as taught by Puschmerat for reducing cost of manufacture of a printing press.

Response to Arguments

Applicants' arguments filed on August 20, 2002 have been fully considered but they are not persuasive of any error in the above rejections.

Applicant argues that the double patenting should be withdrawn because Richards does not claim and disclose an anilox inker and the claims of the instant application are narrower than the claims of Richards.

Note that the use of an anilox inker for inking a plate while not specifically shown in Richards is obvious and necessary to provide an operative device. Also, claim 1 of the instant application does recited the two blankets coupled together as in claim 1 Richards. So, the structure and method claimed in the present application are broader than the claims in Richards. Therefore, the double patenting rejection is proper, and the rejection under 35 USC 102 (e) is repeated.

Applicant argues that Volz, Murray and Puschnerat fail to teach the offset printing press and the method for driving a printing unit as recited. Specifically, applicant argues that Volz does not teach the thrown-off printing cylinder or the anilox inkers. However, applicant argument is more specific than the structure and method recited in claims 1 or 7. For examples, there is neither a thrown-off printing cylinder nor an anilox roll recited in claim 1 or claim 7. Note that the anilox roll as recited in claim 2 having the same function of distributing ink to a plate cylinder as the roller R of Volz.

Applicant argues that Murray does not teach ink form roll which has the same diameter with the plate cylinder. However, while the ink form rollers and the plate cylinder of Murray appear to have the same size or diameter, the selection of a desired diameter of the ink form rollers and the plates involves only an obvious matter of design choice based upon obvious experimentation if in fact Murray does not teach the ink form rollers and the plate cylinder having the same diameter. Also, note that Murray stated that the various sizes of plate cylinders can be used (as explained above). Additionally, Puschnerat is cited to show the conventional blanket to blanket cylinders which are directly geared together.

Therefore, it is believed that the rejections are proper since Volz et al. meets the structure as broadly recited in claims 1,2,4,14 and 17; the combinations of Volz and Murray renders obvious the structure as recited in claims 3,5,16 and 18-13,15 and 18, and the combination of Volz and Puschnerat renders obvious claims 6, 13-15. There is no apparent unobviousness in the structure and method claimed relative to the structure and method of the prior art as applied.

Conclusion

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

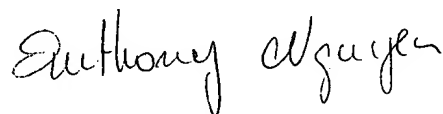
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (703) 308-2869. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (703) 305-6619. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



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10/25/02
Patent Examiner
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